

### **REMARKS**

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

#### **I. Disposition of the claims**

Claims 1-20 are pending. Claims 1-2 and 15 are currently amended. Claims 17-20 are new. Support for each amendment is believed obvious from the claims themselves. No new matter has been added.

This amendment adds, changes and/or deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

#### **II. General**

The specification was objected to due to the title. Office action, p. 2. The present version of the title avoids this issue. Thus, the objection should be withdrawn.

#### **III. Claim objections**

Claim 2 was objected to due to multiple periods (“.”). Office action, p. 2. The present version of claim 2 avoids this objection. Thus, the objection should be withdrawn.

#### **IV. 35 USC § 112, para. 2, Claim Rejections**

Claims 1 and 15 were rejected as being indefinite. Office action, pp. 2-3. Each claim will be addressed under a separate header.

**A. Claim 1**

Claim 1 was rejected for reciting the term “primary particle size” (claim 1) and alternative language, such as “mean particle size,” was suggested. Office action, pp. 2-3. The Examiner is thanked for the helpful suggestions.

The present Amendment replaced “primary particle size” in Claim 1 with --particle size of the primary particle--. Please note that the primary particle of water-repellent resin may or may not agglomerate and to form a secondary particle or an agglomerate having a relatively larger size. The particle size specified for Component (B) in Claim 1 is the particle size of the primary particle, and not the particle size of the secondary particle or the agglomerate having a relatively larger size.

As the claims would have reasonably apprised one of ordinary skill in the art of the meaning, it is respectfully requested that the present rejection be withdrawn.

**B. Claim 15**

Claim 15 was rejected for reciting the term “the coated portion” (line 2), and adding antecedent for this language was suggested. Office action, pp. 2-3. The present version of claim 15 avoids this issue. As the claims would have reasonably apprised one of ordinary skill in the art of the meaning, it is respectfully requested that the present rejection be withdrawn.

**V. 35 USC § 103(a) Claim Rejections**

There are three rejections. Each will be addressed under a separate header after clarifying some procedural matters relevant to each rejection and discussing the present specification’s teachings.

**A. Procedural matters Applicable to Each Rejection**

This section will clarify the record for anyone reading this record who may be unfamiliar with the customs of patent prosecution.

The rejection was read as if WO 02/03928 A1 was the basis for each rejection, but because WO 02/03928 A1 is written in Japanese, U.S. Publication No. 2003-0082218 A1 was cited in the Office action, and passages from it will be cited in this response and the Office action.

The international filing date (actual filing date) of the present application is March 11, 2002, which is before the publication date (May 5, 2003) of Ichinohe et al. U.S. Publication No. 2003-0082218 A1. Furthermore, since U.S. Publication No. 2003-0082218 A1 is based on a PCT application that published in the Japanese language (WO 02/03928 A1), 2003-0082218 A1 itself has no § 102(e) date, but does have a § 102(a) date as of its publication date, May 5, 2003, a date after the filing date of the present application. As a result, U.S. Publication No. 2003-0082218 A1 itself is technically not “prior art” against any claim of the present application.

Yet, as the Examiner and Applicant’s representatives are well aware, 35 USC § 375(b) provides substantial penalties for improperly translated international applications that enter the national phase in the United States. Thus, the Examiner is believed to have cited U.S. Publication No. 2003-0082218 A1 as a prima facie reliable translation of WO 02/03928 A1.

Indeed, the corresponding International publication of Ichinohe et al. (WO 02/03928 A1) was published in Japanese on January 17, 2002, a date before March 11, 2002. So, it would make sense for the Examiner to have cited WO 02/03928 A1, whose prima facie translation is 2003-0082218 A1.

Therefore, the present response traverses each rejection of the claims over Ichinohe et al. (read as WO 02/03928 A1, whose prima facie translation is 2003-0082218 A1) alone and further in view of other teachings, *vide infra*. Furthermore, if Applicant becomes aware of facts that show U.S. Publication No. 2003-0082218 A1 is not a prima facie reliable translation of WO 02/03928 A1, then Applicant reserves the right to present such evidence and traverse the rejection on those grounds, too.

**B. The Present Specification's Teachings**

Recently, with the aim of improving durability of cosmetics such as sun screen, various technologies have been developed. However, the cosmetics using such technologies are still poor in actual performance, particularly when worn in water bathing (page 1, line 13 to page 3, line 6). As to the points, please refer to Comparative Examples 1 and 6, examples of exemplary cosmetics, mentioned in the present specification.

The present inventor studied earnestly to solve the above problems and, as a result, he has found that the cosmetic composition defined in Claim 1 made it possible to achieve excellent durability as well as excellent feeling.

The present cosmetic composition is characterized by comprising specific components, i.e. components (A) to (E), in the recited amounts as defined in Claim 1. Thus, the present cosmetic composition works as an air barrier film when applied to a skin and exhibits water-runability. Therefore, the cosmetic composition is unlikely to come off by water and it becomes possible to ensure lastingness and durability for long hours (see page 4, line 14 to page 5, line 14, and page 18, lines 18 to 31, of the present specification). The fact is supported by the working examples.

From those facts, Applicant respectfully submits that a person of ordinary skill in the art would never have had a reasonable expectation of effects of the present invention from Ichinohe, et al. These points will be explained in some detail in the following sections.

**C. Ichinohe**

Claims 1, 3-10, 12, 14-15, and 16 were rejected as obvious over the teachings of Ichinohe. Applicant respectfully traverses this rejection.

Most inventions arise from a combination of old elements and each element may often be found in the prior art. In re Rouffet, 149 F.3d 1350, 1357 (Fed.Cir. 1998); see, e.g., In re Kahn, 441 F.3d 977 (Fed. Cir., 2006). However, merely identifying each element is insufficient to defeat the patentability of the combined subject matter as a whole. Rouffet, at 1355, 1357. Rather, to establish a prima facie case of obviousness based on a combination of elements disclosed in the prior art, the examiner must articulate the basis on which she concludes that it would have been obvious to make the claimed invention. Id. In practice, this requires the examiner to "explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious." Id. at 1357-59. Moreover, when the examiner does not explain the motivation, or the suggestion or teaching that would have led the skilled artisan at the time of the invention to the claimed combination as a whole, it is inferred that the examiner used hindsight to conclude that the invention was obvious. Id. at 1358.

According to the evidence and explanation, the express teachings of Ichinohe et al. would not have motivated one of ordinary skill in the art to make cosmetic composition comprising components (A) to (E) in the recited amounts, let alone provide a reasonable expectation of success. Specifically, Ichinohe et al. does not concretely disclose any cosmetic composition comprising components (A) to (E) in combination. For example, the cosmetic composition in

Example 11 of Ichinohe et al. lacks components (B) and (E). Further, ignoring the missing ingredients, Ichinohe et al. does not disclose specific amount of each component (A) to (E). From those facts, Applicants submit that a person of ordinary skill in the art would never have had a suggestion to make any cosmetic composition comprising components (A) to (E) in the recited amounts, let alone a reasonable expectation of success.

Nor, according to the evidence and explanation, are there any other teachings of Ichinohe et al. that would not have motivated one of ordinary skill in the art to make cosmetic composition comprising components (A) to (E) in the recited amounts, let alone provide a reasonable expectation of success.

Various non-volatile oil agents and various volatile solvents are exemplified in parallel for the unctuous agent used together with silicone-modified wax in Ichinohe, et al. (paragraphs 17 to 22). The amount of the unctuous agent disclosed in Ichinohe et al. is too broad (1 to 98 weight %, paragraph 23). Further, some compounds exemplified for a compound having at least one alcoholic hydroxyl in its molecular structure in Ichinohe, et al. correspond to volatile solvents (paragraphs 25 and 26). The amount for such compound disclosed in Ichinohe et al. is too broad (0.1 to 98 weight %, paragraph 26).

On the other hand, the present cosmetic composition comprises the recited non-volatile oil agent (component (A)), and the recited volatile solvent (component (D)) in a recited amount (7 to 30 weight % for component (A) and 20 to 60 weight % for component (D)), and it is clear from comparison with the effect of Example 1 to that of Comparative Example 2, the effect of the present cosmetic composition can be obtained thereby. A person of ordinary skill in the art would never have had a reasonable expectation of such effects from the teachings of Ichinohe et al.

Ichinohe does not focus attention on a kinetic viscosity of non-volatile oil agent. It is clear from comparison with the effect of Example 3 to that of Comparative Example 7, to select non-volatile oil having a kinetic viscosity of 5 to 1000 mm<sup>2</sup>/s (component (A)) makes it possible to achieve the present cosmetic composition.

As pointed out in the Official action, polymethyl silsesquioxanes are disclosed in Ichinohe et al. However, polymethyl silsesquioxanes are exemplified for powders and/or coloring agents among various inorganic and organic powders (paragraphs 30, 31 and 33). The amount for such powders and/or coloring agents disclosed in Ichinohe et al. is too broad (0.1 to 99 weight %, paragraph 38).

On the other hand, the present cosmetic composition comprises the recited water-repellent resin powders in a recited amount (0.2 to 5 weight %). It is clear from comparison of the effect of Example 1 to that of Comparative Example 4, to formulate specific water-repellent resin powders in an amount of 0.2 to 5 weight % makes it possible to achieve the present cosmetic composition.

Therefore, it is submitted that the invention according to our proposed Claims 1, 3-10, 12, 14-15 and 16 is not obvious over Ichinohe et al.

D. Ichinohe et al. further in view of Fukuchi (English Translation JP 01211518)

Claim 2 was rejected over Ichinohe et al., further in view of Fukuchi (English Translation JP 01211518). The rejection does not rely upon Fukuchi to remedy the deficiencies of Ichinohe et al. Thus, Applicant submits that the invention according to Claims 1-3-10, 12, 14-15 and 16 is not obvious over the teachings of Ichinohe et al. and Fukuchi.

E. Ichinohe et al. further in view of Hayashi (JP 2000327948A)

Claims 11 and 13 were rejected over Ichinohe et al., further in view of Hayashi. The rejection does not rely upon Hayashi to remedy the deficiencies of Ichinohe et al. Thus,

Applicant submits that the invention according to Claims 1, 3-10, 11-13, 14-15 and 16 are not obvious over the teachings of Ichinohe et al. and Hayashi.

**CONCLUSION**

The present application is believed to be in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date

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By

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